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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,330	05/19/1999	ARTURO MARIA	113306	5017
23838	7590	11/21/2003	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			JACKSON, JENISE E	
		ART UNIT		PAPER NUMBER
		2131		6
DATE MAILED: 11/21/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

MPQ

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/314,330	MARIA, ARTURO
	Examiner	Art Unit
	Jenise E Jackson	2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-18 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \*    c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 4, 6-12, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Squilla.

3. As per claims 1, 8-9, 11, Squilla discloses et al. discloses identifying an image using electronic means, because Squilla et al. discloses identifying an image of a digital camera(see col. 4, lines 38-40), receiving an image in electronic storage(see col. 4, lines 42-46). The Examiner asserts that the terms personal information, is broadly defined to be any information that is personal. The Examiner asserts that Squilla discloses receiving personal information, because Squilla discloses a private key(i.e. personal information) that is associated with the digital camera(see col 7, lines 45-47). The Examiner asserts that although Squilla does not explicitly disclose a mark, the Examiner asserts that Squilla does disclose a mark, because Squilla discloses that the private key is embedded into the image of the digital camera, the Examiner asserts that this method is a mark(see fig. 5, sheet 4), producing information by comparing an image of the mark with a plurality of portions of the image(see col. 8, lines 1-51), deriving a signature uniquely identifying the image from the information(see fig. 5, sheet 4). As per claims 8-9, and 11, generating a second mark, a second signature is not explicitly disclosed

in Squilla. However, Squilla system includes a digital camera, that captures images. Thus, the Examiner asserts that since multiple pictures can be taken with a digital camera, and Squilla discloses a mark and signature.

4. As per claims 2, 12, Squilla discloses deriving the signature includes apprehending the signature in the information(see fig. 7, sheet 6).

5. As per claims 4, 14, Squilla discloses deriving the signature includes inserting the signature into the image(see fig. 4, sheet 3).

6. As per claim 7, Squilla discloses wherein the image is on a document and the method further includes storing the signature on the document, apart from the image(see fig. 6, sheet 5, 82).

7. As per claim 10, Squilla discloses comparing the image with a mark of the image(see col. 7, lines 30-67, col. 8, lines 1-19); thus, the Examiner asserts that a copy is made of the image to determine whether the image has been altered.

#### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Squilla. As per claim 6, Although Squilla discloses that the mark and signature are stored in removable storage. The Examiner takes Official Notice, that storing is a persistent(i.e. non-volatile) storage is known, the motivation is that even if power is cut off the contents still remains intact.

10. Claims 3, 5, 13, 15-16, are objected to as being dependent on rejected base claims. As per claims 3 and 5, 13, the allowable subject matter being apprehending includes applying a threshold to the correlation results to produce a candidate string and encoding the candidate string, and also allowable subject matter of claims 15-16 includes the means of inserting includes altering the contents of the image at one or more locations when the correlation of those contents with the image contents of the mark exceed the threshold .

*Response To Amendment*

11. Applicant's first remark in paper number 10, is in reference to the prior art that was used in previous rejection dated March 21, 2003, the prior art of record that was used was Squilla. The Applicant states in paper number 10, that Squilla does not disclose or suggest a mark. The Applicant states that Squilla only discloses that a private key is used to encrypt an image but does not discloses or suggest that a private key is embedded into the image of the digital camera. The Examiner agrees with the Applicant that the private key is used to encrypt an image. However, Squilla does disclose a mark, because Squilla discloses that a digital camera that has embedded a private key unique to the digital device(see col. 3, lines 1-6).

12. Secondly, the Applicant states that Squilla does not disclose deriving a signature uniquely identifying the image from the information. The Examiner disagrees a signature is derived that uniquely identifies the image from the information(see col. 7, lines 31-67, col. 8, lines 1-16).

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

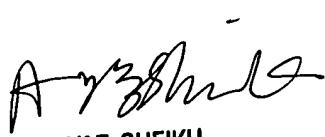
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (703) 306-0426. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-0040 for regular communications and (703) 308-6306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
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November 17, 2003

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100